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09/920,512

08/01/2001

Joseph Michael Bennett

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Dayton, OH 45424

EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,512

Applicant(s)

BENNETT, JOSEPH MICHAEL

Examiner

Daniel A Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Semple et al. (US 6,085,177). Semple et al. teach all of the elements and means as recited in claims 1-4, 6-8 and 11. For example, Semple et al. teach the following:

Re claim 1: See all of Semple et al. An ATM providing Internet access (column 2, lines 57-67) is the subject of the invention. Terminal screen, a keypad, and menu keys are all present. A keyboard 228 is recited (column 4, lines 13-24). An Internet connection is present (column 4, lines 13-24). That program code exists to access the Internet facilitating display based on keypad and / or menu input is indicated in columns 4 and 5, and is also implicit.

Re claim 2: The abstract recites charging via the ATM banking system. See also column 4, lines 23-25 and figure 1, ref. 228, which show an ATM card reader.

[Note: One can see a similar ATM+Internet system whose billing is made even more explicit – Barcelou WO 97/45796 – which discusses the claimed fee charging arrangement in even greater detail. See abstract and throughout that document.]

Re claim 3: The terminal, in and of itself, provides both ATM and Internet access, as Semple et al. makes clear throughout.

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Re claim 4: Internet access has been discussed by Semple et al. [Note: Barcelou (pages 5 and 6) teaches all manner of other applications that are also recited in the claim.]

Re claim 6: A keyboard (column 4, lines 47-49) for user interface to the Internet implies entry of Internet addresses as needed, since Netscape (column 4, line 55) which has this feature, is employed.

Re claim 7: Hotmail (a world-wide-web based email system) was available since at least 1997 and would have been accessible on the claimed system. For evidence of the above stated date, see press release, "Microsoft Acquires Hotmail!" dated December 31, 1997.

Re claim 8: The claimed capability is the basic action enabled by a web-based email system accessed on the kiosk of Semple et al.

Re claim 11: Advertisements have been ubiquitous on the Internet since the 1990s.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Barcelou (WO 97/45796).

Note: Barcelou anticipates at least some other claims; however, Semple has already been employed.

Barcelou teaches an "integrated but otherwise traditional ATM" (page 3, lines 26-27). One additional service is "Internet services" (page 5, line 30). Figure 4 shows the ATM / POS terminal 40. See page 4, line 34-page 5, line 15 for description of components. The screen and screen menu keys are achieved by the touchscreen 44. Figures 3a-3e all show data transmission

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lines (i.e. a network connection). Suitable electronic programming code for accessing the Internet upon customer input is implied.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barcelou. The teachings of Barcelou regarding claim 1 have been discussed above.

Re claim 5: Barcelou requires numerical entry of data be a touchscreen, because that is the essential user interface. As for a telephone keypad arrangement, that amounts to design choice, and one would have been motivated to do so for the sake of user friendliness.

Re claim 9: See figure 2; page 3, lines 20-25: A jukebox is combined with an ATM. See figure 3a: The jukebox embodiment has a network connection. Song websites were available at

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the time of the invention, and the motive to provide access to those song sites would have been to increase the number of available songs.

Re claim 14: See Barcelou, figure 2: one combination made by Barcelou is a combined ATM and movie ticket dispenser. Regarding printing (as per claim 12), Barcelou has this.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barcelou in view of Green et al. (US 6,041,310).

Barcelou teaches an ATM additionally having (page 7, line 6) “insurance and brokerage services” but does not elaborate.

Green et al. teaches (entire document ; notably column 14, lines 5-26) a kiosk enabling auto insurance application at a car dealership, running software that will generally meet the claimed limitations. In view of Green’s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known kiosk insurance application system of Green in the teachings of Semple et al. for the sake of increased user convenience at car dealerships.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Semple et al.

Re claim 12: See discussion re claim 1 above. Also note, Semple has a printer (ref. 236; column 4, lines 57-65) that can perform the claimed printing functions. That a receipt printer could be used would have been a design choice motivated by cost effectiveness.

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Re claim 13: All of the recited features are available on the Internet, to which Semple et al. gives access.

Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Semple et al. in view of Namias (US 20020112005).

Re claims 15 and 17: Semple et al. teaches (see claim 1) all of the elements needs for Namias' capability except a camera and the necessary software; all other hardware is present.

Namias et al. teaches (figure 1, ref. 130) a camera and has software to employ it for the claimed interactive purpose.

In view of Namias' teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known camera and associated interactive software of Namias in the teachings of Semple et al. because the user experience is thereby enhanced.

Re claim 16: Most ATM systems come with a video camera present, as part of a security system. To use this camera also for the interactive purpose of claim 15 would have been obvious, because it saves the cost of using two cameras, when just one would have been sufficient.

Re claims 18 and 19: Namias does not require a remote site to be either a computer or a kiosk; both can receive video email. Semple et al., with webmail, could similarly receive video email.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ramachandran (US Prov. App. 60/180,490, referenced in US 6,457,640) teaches an Internet-accessing ATM.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH

DANIEL STCYR
PRIMARY EXAMINER

